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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,891	10/19/2001	Emine Capan	P/2107-181	2941

2352 7590 12/02/2003

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NEW YORK, NY 100368403

EXAMINER

KRISHNAN, GANAPATHY

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,891

Applicant(s)

CAPAN ET AL.

Examiner

Ganapathy Krishnan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8,9,13-16,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,8,9,13-16,19 and 20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The Amendment B (paper 10) filed September 15, 2003 has been received, entered into record and carefully considered. The following information provided in the amendment affects the instant application:

1. Claims 2-7, 10-12 and 17-18 have been cancelled.
2. Claims 1, 8, 9 and 14 have been amended.
3. New claims 19 and 20 have been added.
4. Remarks/Arguments drawn to the rejection of claims under 35 U.S.C. 112 first and second paragraphs and 102(a).

Claims 1, 8-16, 19 and 20 are pending.

Claim 1 recites carbohydrates, alcohols, aldehydes or polyhydroxy compounds.

Applicants elected carbohydrates as the species for prosecution (paper 7) without traverse. An action on the merits of the pending claims with carbohydrates as the species is contained herein below.

Claim Rejections - 35 USC § 112

The rejection of claims 8 and 9 under 112 first paragraph advanced in the previous office action has been overcome by amendments.

The rejections of claims 8, 9 and 13 under 112 second paragraph advanced in the previous office action have been overcome by amendments. The rejections of claims 11 and 12 have been rendered moot by cancellation.

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Claims 1, 8-9, 13-16 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: Claim 1 is drawn to a process for the conversion of carbohydrates comprising carrying out the conversion using a polymer coated metal particle as catalyst. It is not clear what type of conversion is intended. The claim also does not recite any positive process steps involved in the said conversion.

In Claim 14 it is not clear what "nanoparticle-stabilizing polymer" means. The recitation lacks antecedent basis. Independent claim 1 recites polymer-coated metal particle. It is not clear if the same is intended here or if another polymer is added.

Claims which depend from a rejected base claim, which do not obviate the reason(s) said base claim is/are rejected, are also rejected under 35 U.S.C. 112 second paragraph for the reasons of record said base claim is rejected.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1, 8, 9, 13, 19 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19 and 20 of copending Application No. 10/340913 ('913 application). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application recites the same limitations as claim 19 of the '913 application, the difference being that the type of conversion is oxidation as recited in claim 19 of the '913 application, whereas claim 1 of the instant application recites the broader term "conversion" which encompasses oxidation. The recitation "carbohydrates" in instant claim 1 is seen to encompass all of the carbohydrates recited in claim 20 of the '913 application. Claims 8, 9, 13, 19 and 20 of the instant application recite a noble metal, a base metal, a metal catalyst with a promoter metal, and specific base and noble metals. These recitations are seen to be encompassed by Claim 19 of the '913 application which recites a polymer-coated metal particle. It does not matter if the metal is polymer coated or not as long as a metal is present.

It would be obvious to one of ordinary skill in the art that the process claimed in the copending '913 application and the instant application are substantially overlapping. The process of the instant invention must contain new and distinguishable measures over the copending application to be patentably distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

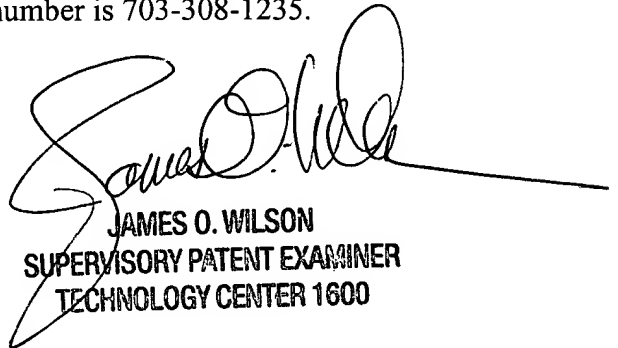
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ganapathy Krishnan whose telephone number is 703-305-4837. The examiner can normally be reached on 8.30am-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 703-308-4624. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

GK



JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600